

Application No. 09/787,549
Amendment dated August 3, 2004
Reply to Office Action dated February 6, 2004

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Remarks

Claims 1-13 and 15-18 are pending, with claims 1 and 16 being in independent form.

As a preliminary matter, the Examiner is again reminded that form PTO-1449, submitted by Applicants on June 1, 2001, as part of the First Information Disclosure Statement, was returned without initialing the box adjacent to the listed Nikkei Electronics publication. The Examiner is again requested to return a fully Examiner-initialed copy of the form to the undersigned indicating that all documents have been considered. The Examiner is invited to contact the undersigned immediately if the Nikkei Electronics publication cannot be located.

Applicants wish to thank the Examiner for the courtesy extended during a telephonic interview with the undersigned representative on August 2, 2004. During the interview, the Examiner agreed to fully consider the below arguments and respond to each argument in detail, since the Examiner's position with respect to the arguments was not stated in the Advisory Action mailed June 17, 2004.

In the Office Action, claims 1-18 stand rejected for obviousness by U.S. Patent No. 6,405,203 to Collart ("Collart") in view of U.S. Patent No. 6,185,321 to Fukushima et al. ("Fukushima"). Each of these rejections is respectfully traversed.

Applicant describes a copyright information management system including a copyright information management center, provided in a product distribution environment where products, in the form of digital content, are distributed through electronic transmission between a product provider comprising at least one of a copyright owner creating a product and a distributor distributing the product, and a product user receiving the product from the product provider. The system exchanges copyright information relating to the product through the electronic transmission with both of the product provider and the product user. The copyright information management center centrally manages all copyright information existing in the product distribution environment through the electronic transmission by preregistering copyright information relating to the individual products in the center. The copyright information includes product provider information and product information and is available for retrieval by the product user at a time beginning prior to receiving the product in a final form. That is, inquiries regarding the product can

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be made to the copyright information management center by the product user at the time of the transaction.

It is well established that three criteria must be met to establish a prima facie case of obviousness. First, the cited documents must teach or suggest all of the claim limitations. Second, there must be some suggestion or motivation, either in the cited documents themselves or in the knowledge generally available to one of ordinary skill in the art, to have combined the teachings of the cited documents. Third, there must have been a reasonable expectation that the documents could have been successfully combined.

The rejections cannot stand at least because no combination of the cited documents teaches all of the claim limitations. Moreover, the cited documents would not have supplied any motivation to combine them as suggested by the Action. Finally, there would have been no reasonable expectation that such complex documents could have been successfully combined to yield a working system, which even then would have had to be further modified to obtain the claimed subject matter.

The Examiner admits in the Action that Collart does not disclose or suggest that copyright information is available for retrieval by the product user at a time beginning prior to receiving the product in a final form, as defined by claims 1 and 16. The Examiner contends, however, that this feature would have been obvious to a person skilled in the art in view of Fukushima's digital copying machine in which a copy-prohibited image is preregistered. Applicants disagree.

According to claims 1 and 16, the preregistered copyright information includes product provider information, such as the name and address of each copyright owner, and product information, such as licensing conditions, name of the work and classification of the work. That is, the preregistered copyright information are not the copyrighted works per se, such as the image data, but are product provider information and product information about the copyrighted works that is available for retrieval by the product user prior to receiving the product in a final form. This not disclosed or suggested in Collart and Fukushima, alone or in combination.

In contrast, Fukushima discloses the image data itself is preregistered in the copy machine. In some embodiments, specific portions of the image are compared

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to a preregistered image, such as the word "confidential". Nowhere in Fukushima, however, is it disclosed or suggested that product provider information and product information about the image are preregistered and available for retrieval by the product user prior to receiving the product in a final form.

Moreover, Fukushima discloses preregistering image data to determine if an image is copy-prohibited. There is once again, as in Collart, no information available for retrieval by the product user prior to receiving the product in a final form. The copy machine does not offer any information on which the user can retrieve and make a decision. Instead, the copy machine merely prevents copying of copy-prohibited images at a time that the user has already decided to make a copy of the image. That is, Fukushima is directed to preventing the illegal copying of copy-prohibited images.

According to claims 1 and 16, both the product provider information and the product information are preregistered in the copyright information management center and are available for retrieval by the product user. The systems and methods of the present invention provide information to a product user to promote the proper distribution of copyrighted products, not just merely prevent illegal activities as in Fukushima. This difference is not surprising, since the copy machine of Fukushima is directed to prohibiting the copying of legally-sensitive image data, such as marketable securities, e.g., stocks or monies, which is a radically different concern than that of the present invention.

In addition, Fukushima is directed to copying, e.g., a "copy action" of an object is an essential process. In contrast, the present invention is concerned with distribution of copyrighted products.

Accordingly, since the combination of Collart and Fukushima fails to disclose or suggest all of the claim limitations for at least the above reasons, the obviousness rejections of the claims should be withdrawn.

The second requirement of a prima facie case of obviousness is also missing here. One of ordinary skill in the art would have had no motivation to combine Collart and Fukushima at least because the problems that Collart and Fukushima aim to solve are different. Fukushima is not concerned with tracking the distribution of articles of manufacture, which is the problem Collart was trying to solve, and thus

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it is hard to understand why one knowing Collart would have been motivated to look to the copy machine of Fukushima for anything. The Action's suggestion that the documents can be combined ignores the great technical differences between them that would have made such a combination improbable to say the least.

Moreover, there is no basis for the Examiner's contention in the Action (p. 3) that "it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the electronic storage medium of Collart by including the limitation detailed above as taught by Fukushima because this would determine if the copy data as received via the electronic transmission are prohibited to be copied." This motivation is not present.

Collart is not concerned with electronic transmission of copy data at all. As pointed out in our previous response, Collart relates to a method and system for tracking the distribution of conventional electronic storage medium-based products, such as DVDs or CDs. A consumer purchases and receives a physical product in the form of a packaged electronic storage medium at a store or through the mail, for example. The medium itself and the package the medium is sold in both contain a storage medium tracking identifier. See Abstract and col. 5, l. 62 to col. 6, l. 62. The system in Collart does not distribute products to a product user through electronic transmission, which is the basis of the Examiner's motivation.

In addition, Collart is not concerned with the copying of electronic storage medium-based products once they are received by the end user, and so one would not be motivated to look to Fukushima to address these concerns.

As discussed above, Fukushima is concerned only with the copying of copy-prohibited image data.

It is respectfully submitted that the suggestion to combine such disparate documents, with no indication of any motivation for the combination of the documents themselves, may reflect a use of Applicant's claims as mere templates for picking isolated features from the art. Such hindsight reconstruction is improper. E.g., Sensonics, Inc. v. Aerosonic Corp., 38 U.S.P.Q.2d 1551 (Fed. Cir. 1996); In re Oetiker, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992) (reversing an obviousness rejection and stating the "reason, suggestion, or motivation" to combine (or modify) prior art "can not come from the applicant's invention itself. [Citation omitted.]").

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Since there would have been no motivation to combine Collart and Fukushima as suggested in the Action, the second requirement of a prima facie case of obviousness is missing, and the obviousness rejections of the claims should be withdrawn for this reason, too.

The third requirement of a prima facie case is also missing. Even if one had attempted to combine the disclosures of the cited documents, one would have been more likely to arrive at something that did not work at all or not in the manner claimed by the present application. As discussed above, one of ordinary skill in the art would have known that the features of Collart and Fukushima cannot be combined without further modification to reach the subject matter defined by the claims. For example, neither document discloses that product provider information and product information about the image are preregistered and available for retrieval by the product user prior to receiving the product in a final form, as discussed above. In the absence of any suggestion in the cited documents of how to make such a combination operable, one would have faced a serious engineering problem that naturally would have had a low probability of success without substantial experimentation and effort, especially in view of the need to modify the teachings of the documents. It is well settled that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make that modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992).

Accordingly, the combination of documents relied upon to support the obviousness rejection of claims 1-13 and 15-18 is improper and the claim rejection should be reconsidered and withdrawn.

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For the foregoing reasons, Applicants consider the application to be in condition for allowance and respectfully request notice thereof at an early date. The Examiner is encouraged to telephone the undersigned at the below-listed number if, in the Examiner's opinion, such a call would aid in the examination of this application.

Respectfully submitted,

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I hereby certify that this correspondence is being sent by facsimile transmission to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 to the following facsimile number:

Facsimile Number: 703 872 9306
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Kathryn L. Boyd